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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. 10007750-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Carl S. Chow

Confirmation No.: 4263

Application No.: 09/905,579

Examiner: Robinson Boyce, Akiba K.

Filing Date: July 12, 2001

Group Art Unit: 3628

Title: Literature Distribution Methods and Apparatus

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on March 27, 2007.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month
\$120

☐ 2nd Month
\$450

☐ 3rd Month
\$1020

☐ 4th Month
\$1590

☐ The extension fee has already been filed in this application.

☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 500. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

☒ I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
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☐ I hereby certify that this paper is being transmitted to the Patent and Trademark Office facsimile number (571)273-8300.

Date of facsimile:

Typed Name: Thomas Olson

Signature: Thomas Olson

Respectfully submitted,

Carl S. Chow

By Thomas Olson

Thomas Olson

Attorney/Agent for Applicant(s)

Reg No. : 44,271

Date : May 24, 2007

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Date of Deposit: May 24, 2007

Typed Name of Person Mailing Paper or Fee: Thomas A. Olson



PATENT APPLICATION

Docket No.: 10007750-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND
INTERFERENCES

In re application of:

Inventor(s): Carl S. Chow
Serial No.: 09/905,579
Filed: July 12, 2001
Title: Literature Distribution Methods and Apparatus
Art Unit: 3628
Examiner: Robinson Boyce, Akiba K.
Confirmation No.: 4263

Mail Stop APPEAL BRIEF – PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

APPEAL BRIEF

SIR OR MADAM:

This communication is the Appeal Brief in this application with respect to the Notice of Appeal filed on March 27, 2007. This Appeal Brief is being filed under the provisions of 37 C.F.R. § 1.192. The filing fee for filing this Appeal Brief, as set forth in 37 C.F.R. § 1.17(c), is included herewith as indicated on the attached Transmittal of Appeal Brief.

(Continued on next page.)

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Serial No. 09/905,579
Docket No. 10007750-1
Appeal Brief

1. Real Party In Interest:

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

2. Related Appeals and Interferences:

There are no other appeals or interferences known to Appellant, the Appellant's legal representative, or Assignee which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

3. Status of the Claims:

The following list provides the status of all the claims in the application:

Claims 1-18: cancelled;

Claims 19-34: rejected – currently on appeal.

4. Status of Amendments:

In the final action, all the claims were rejected under 35 U.S.C. 112, first paragraph, for failing to comply with the enablement requirement. These rejections were based on a phrase that had been added to claims 19 and 27 in a previous amendment. In a response to the final action, Appellant filed amendments to claims 19 and 27, wherein the phrase was substantially changed in order to overcome the rejections under 35 U.S.C. 112. In the advisory action, the Examiner indicated that the after final amendments would be entered for purposes of appeal. Also, the rejections under 35 U.S.C. 112 were not mentioned in the advisory action. The Appellant therefore assumes the rejections under 35 U.S.C. 112 have been overcome. No other amendments have been filed or entered after the final action.

5. Summary of Claimed Subject Matter:

The summary corresponds to independent claims 19 and 27, which are the independent claims on appeal. Discussions about elements and recitations can be found at least at the cited locations in the specification and drawings.

Claim 19:

With respect to claim 19, which is the first independent claim on appeal, a method includes providing an interface (140), and an algorithm (205), and a database (203) containing information. The interface (140) can include at least a portion of a network (120C) such as the Internet or a telecommunication network. Furthermore, the interface (140) can include a telephone or a personal computer, for example. A client ("C") can make an inquiry via the interface (140). The client inquiry is detected and then, in response, the information in the database (203) is presented to the client ("C") via the interface (140). The client ("C") makes a selection of certain information in which the client is interested. The client selection is received via the interface (140) and, in response, the selected information is assembled into a document by the algorithm (205). In assembling the selected information into a document, the algorithm (205) automatically arranges and organizes the selected information in a logical sequence of components to create the document. Next, an electronic image is obtained, wherein the image includes the document and a postage marking that is calculated based on the total weight of a booklet ("B"). The electronic image is printed onto one or more sheets of media ("M") to create the booklet ("B"). (See specification at page 7, line 20, through page 11, line 28, and page 12, lines 22-32, and page 26, line 24 through page 19, line 20, and page 22, lines 11-19, and Figure 3.)

Claim 27:

With respect to claim 27, which is the second independent claim on appeal, a method includes providing an interface (140), and an algorithm (205), and a database (203) in the form of a read only memory device that contains information. The interface (140) can include at least a portion of a network (120C) such as the Internet or a telecommunication network. Furthermore, the interface (140) can include a telephone or a personal computer, for example. A client ("C") can make an inquiry via the interface (140). The client inquiry is detected and then, in response, the information in

the database (203) is presented to the client ("C") via the interface (140). The client ("C") makes a selection of certain information in which the client is interested. The client selection is received via the interface (140) and, in response, the selected information is retrieved from the read only memory device (203) and is assembled into a document by the algorithm (205). In assembling the selected information into a document, the algorithm (205) automatically arranges and organizes the selected information in a logical sequence of components to create the document. Next, an electronic image is obtained, wherein the image includes the document and a postage marking that is calculated based on the total weight of a booklet ("B"). The electronic image is printed onto one or more sheets of media ("M") to create the booklet ("B"). (See specification at page 3, line 32, through page 8, line 30, and page 12, lines 9-31, and Figures 1-9.)

6. Grounds of Rejection to be Reviewed on Appeal:

Whether claims 19-34 are unpatentable under 35 U.S.C. 103 over U.S. Patent No. 6,134,568 to Tonkin in view of European Patent Application No. 0621563 A1 by Long.

7. Argument:

The Appellant argues that claims 19-34 are not *prima facie* obvious under 35 U.S.C. 103 over Tonkin in view of Long, as discussed herein below.

CLAIM 19: Claim 19 is not obvious over the cited references for the following reasons:

1) The cited references do not disclose all the claim limitations: Obviousness requires that the prior art references teach or suggest all the claim limitations. (MPEP 2142.) Claim 19 includes the following limitation:

providing ... a literature assembly algorithm, and ... assembling the selected information into a document, wherein the algorithm automatically specifies an arrangement of components to create the document.

The Examiner, in the advisory action, contends that Tonkin discloses this limitation. Specifically the Examiner contends that this limitation is taught by Tonkin because Tonkin discloses a system where computer programs are used to produce data which is output to the display assembly as shown in col. 5, lines 12-21, and that
5 Tonkin further discloses automatic formatting order information in col. 14, lines 57-59, wherein order information is made by the user, and consists of component objects as shown in col. 10, lines 23-37.

At the first location cited by the Examiner (col. 5, lines 12-21), Tonkin merely discloses the principle that information can be input into a computer system by typing
10 on a keyboard, manipulating a mouse or trackball, or "writing" on a tablet or on a position-sensing screen of a display assembly, and that a CPU processes the data under control of an operating system and an application program in order to perform the inventive steps taught by Tonkin, and that the CPU also typically produces data which is output to a display assembly to produce appropriate images on a
15 display screen.

At the second location cited by the Examiner (col. 14, lines 57-59), Tonkin merely discloses the concept of automatically formatting order information so as to facilitate routing and/or document assembly.

At the third location cited by the Examiner (col. 10, lines 23-37), Tonkin merely
20 discloses a means of checking whether a document can be physically created as specified. For example, such means for checking can determine whether the user has specified double-sided printing on media that is capable only of single sided printing, or whether the user has specified color printing for a media that is intended only for black and white printing, or whether the user has specified a binding type that can not
25 accommodate the document because the document would be too thick or too thin, or whether the user has specified printing on media that can not be printed upon, such as vinyl media.

The Appellant notes that in evaluating whether a *prima facie* case of obviousness is established, each term in the claim is to be given its broadest
30 reasonable construction consistent with the specification. (37 CFR 1.56(b)(2)(ii).) The Appellant's specification reads as follows:

“The literature assembly algorithm 205 can comprise a series of computer-executable steps (“a program”) which can be stored in the memory 201 and executed by the processor 215. That is, the literature assembly algorithm 205 is preferably configured to cause the processor 215 to access the database 203 and to retrieve therefrom the specific literature which is requested by the client “C.” After accessing the database 203, and retrieving the requested literature therefrom, the literature assembly algorithm 205 causes the processor 215 to **organize the requested literature together in a logical sequence and order**, and formats the literature for printing in the booklet “B” to be produced by the booklet-producing device 130.” (Specification, page 10, lines 11-19, emphasis added.)

Thus, when viewed in light of the specification, the claim term, “*wherein the algorithm automatically specifies an arrangement of components to create the document*” includes automatically organizing the requested literature together in a logical sequence and order.

The Appellant asserts that, not only do the portions of Tonkin cited by the Examiner fail to show that Tonkin teaches or suggests this claim limitation, but also that nothing in Tonkin teaches or suggests this claim limitation. That is, the references do not teach or suggest all the claim limitations because the references do not teach or suggest the limitation, “*providing ... a literature assembly algorithm, and ... assembling the selected information into a document, wherein the algorithm automatically specifies an arrangement of components to create the document*” as is required by claim 19.

2) The Examiner has not shown that there is a suggestion or motivation to combine the reference teachings: Obviousness requires some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings. (MPEP 2142.) Moreover, all the teachings of each reference must be considered in the question of whether a suggestion or motivation to combine the references exists. (MPEP 2143.01.) That is, it is improper to take elements of the prior art wholly out of context and give them significance they would not have had to one skilled in the art having no knowledge of

the claimed invention, or to anyone else who can read the prior art with understanding. (In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (Fed. Cir. 1988).) In other words, it is impermissible within the framework of § 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. (Bausch & Lomb, Inc., v. Barnes-Hind, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).)

The Appellant asserts, therefore, that a determination as to whether there is some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to combine the reference teachings must at least take into account some basic inventive matter as suggested by the reference teachings as a whole. That is, a proper determination of whether a suggestion or motivation to combine the reference teachings cannot be based only on an insignificant or inconsequential portion of the reference teachings. Otherwise, every patent application could be rejected as being obvious by picking and choosing an element here and an element there. Accordingly, when judging whether there is motivation in the prior art to combine the references, it is important to examine the reference teachings as a whole.

Tonkin teaches a system that enables a user to preview a document before that document is actually produced. That is, Tonkin teaches a system in accordance with which a user inputs various characteristics of a document, and wherein the system generates a computer-generated simulation, or model, of the document based on the characteristics specified by the user. The user can then look at the model of the document to get a better understanding of the appearance of the actual document if the document were to be produced. (Tonkin, abstract.)

Long teaches a system that reads data from a data card, and then, based on the information, prints a letter on a sheet of media, then also based on the information, selects specific inserts to be included with the letter. After printing the letter and selecting the inserts, the system folds the letter, and stuffs the letter with selected inserts into an envelope and calculates the required amount of postage for the letter, inserts and envelope. (Long, abstract.)

In the final action, the Examiner states that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to calculate the

exact postage for the booklet of Tonkin based on the total weight of the booklet and print the electronic image (including the postage) onto one or more sheets of print media at the document production locations, as taught by Long, for the purpose of charging proper postage to the corresponding booklet. (Final action, page 5, emphasis added.)

The Appellant asserts that the Examiner is picking and choosing from the reference teachings in order to support the Examiner's position. That is, the Examiner is relying only upon an insignificant and/or inconsequential portion of what is taught by Tonkin in making the determination that the requisite suggestion or motivation to combine the reference teachings exists. Specifically, the Examiner's position relies upon Tonkin only for teaching "a booklet" and nothing more.

However, what Tonkin discloses is a system for electronically previewing the appearance of a document that has various characteristics specified by a user, and for allowing the user to rearrange the document and/or change the characteristics. The Appellant contends that the Examiner has totally ignored these teachings of Tonkin, and that it is therefore evident that the Examiner has impermissibly excluded all of the elements of Tonkin necessary to the full appreciation of what Tonkin fairly suggests to one of ordinary skill in the art. Thus, the Examiner has not shown a suggestion or motivation to combine what Tonkin teaches with what Long teaches based on some logical reason apparent from positive, concrete evidence that justifies a combination of the reference teachings, as is required. (In re Laskowski, 871 F.2d 115, 10 USPQ 2d 1397 (Fed. Cir. 1985).)

The Appellant also notes that the problem confronted by the inventor must be considered in determining whether it would have been obvious to combine references in order to solve that problem, and that the solution of a problem by the Applicant, which is different from that solved by the prior art is a factor weighing toward nonobviousness. (Northern Telecom, Inc., v. Datapoint Corp., 908 F.2d 931, 15 USPQ 2d 1321 (Fed. Cir. 1990), see also In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (Fed. Cir. 1988).) It is apparent from the Appellant's specification that the general problem confronted by the Appellant was that of effectively and efficiently providing printed information to a person who selects such information from a larger database of information.

By contrast, neither Tonkin nor Long confronted the problem that was confronted by the Appellant. Specifically, Tonkin confronted the problem of ensuring a satisfactory appearance of a document before the document is actually produced, while Long confronted the problem of ensuring that the proper corresponding enclosures are included with a letter, and ensuring that the proper postage is affixed to an envelope containing the letter and enclosures. Thus, both Tonkin and Long confronted problems that are significantly different than the problem confronted by the Appellant.

For at least these reasons discussed above, the Appellant contends that there is no suggestion or motivation to combine the reference teachings.

3) The Examiner has employed impermissible hindsight reconstruction: The suggestion or motivation to combine the reference teachings must be shown to exist before the date of invention. (35 U.S.C. 103(a) (*differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made*).) In other words, it is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. (*In re Fritch* 972 F.2d 1260, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1998).)

As is discussed above, the Examiner’s explanation of the suggestion or motivation to combine the reference teachings reads as follows:

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to calculate the exact postage for the booklet of Tonkin based on the total weight of the booklet and print the electronic image (including the postage) onto one or more sheets of print media ... (Final Office action, page 7, emphasis added.)

As near as the Appellant can tell, the term “booklet” does not appear anywhere in either Tonkin or Long. Rather, Tonkin uses the term, “document,” and Long uses the terms, “letter sheet,” “envelope,” “enclosures,” and “inserts.” Similarly, the Appellant has not found anything similar to the phrase or concept of “print the electronic image including postage” in either of the cited prior art references. Rather, Long simply describes

printing postage on an envelope, while Tonkin fails to teach or suggest postage in any way.

On the other hand, the Appellant uses the term “booklet” throughout the specification, including the claims. Likewise, the concept of printing the electronic image including the postage is introduced and explained in detail by the Appellant in the specification, and is also included in one of the limitations of claim 19. That is, the Appellant defines at least a portion of the invention in terms of “printing the electronic image including the postage,” but this phrase and/or concept is nowhere to be found in the prior art references.

Since the Examiner has used terminology and concepts (i.e., “booklet” as well as the idea and wording of “printing the electronic image including postage”) that appear only in the Appellant’s specification and not in the references, It can be concluded with near certainty that the Examiner has taken that terminology and those concepts not from the prior art, but directly from the Appellant’s own specification and claims.

Thus, it is evident that the Examiner has used the Appellant’s own claim terminology as a template in formulating the explanation of the motivation or suggestion to combine the reference teachings. That is, it is evident that the Examiner has employed impermissible hindsight reconstruction in an attempt to render the claimed invention obvious. Stated yet another way, the Examiner has not shown that the motivation to combine or modify the references existed in the prior art before the date of invention, as is required.

4) The cited prior art teaches away from the claimed invention: A *prima facie* case of obviousness may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. (MPEP 2144.06.) A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be led in a direction divergent from the path that the applicant took. (In re Gurley, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994).)

As discussed above, Appellant’s claim 19 includes the following claim limitation: “assembling the selected information into a document, wherein the algorithm automatically specifies an arrangement of components to create the document.”

By contrast, Tonkin teaches that the user inputs information specifying an arrangement of components to create the document. (Tonkin, abstract.) That is, the

teachings of Tonkin directly contradict the invention of claim 19 because the Appellant claims that the algorithm automatically specifies an arrangement of components to create the document, while Tonkin teaches that the user specifies an arrangement of components to create the document.

Thus, it is evident that a person of ordinary skill in the art, upon reading Tonkin, would be led in a direction divergent from the path the Appellant took. Therefore, even if a *prima facie* case of obviousness had been established, it has been rebutted by the Appellant because the Appellant has shown that Tonkin, in a material respect, teaches away from the claimed invention.

CLAIM 27: Claim 27 is not obvious over the cited references for the following reasons:

1) The cited references do not disclose all the claim limitations: Obviousness requires that the prior art references teach or suggest all the claim limitations. (MPEP 2142.) Claim 27 includes the following limitation:

providing ... a literature assembly algorithm, and ... assembling the selected information into a document, wherein the algorithm automatically specifies an arrangement of components to create the document.

The Examiner, in the advisory action, contends that Tonkin discloses this limitation. Specifically the Examiner contends that this limitation is taught by Tonkin because Tonkin discloses a system where computer programs are used to produce data which is output to the display assembly as shown in col. 5, lines 12-21, and that Tonkin further discloses automatic formatting order information in col. 14, lines 57-59, wherein order information is made by the user, and consists of component objects as shown in col. 10, lines 23-37.

At the first location cited by the Examiner (col. 5, lines 12-21), Tonkin merely discloses the principle that information can be input into a computer system by typing on a keyboard, manipulating a mouse or trackball, or "writing" on a tablet or on a position-sensing screen of a display assembly, and that a CPU processes the data under control of an operating system and an application program in order to perform the inventive steps taught by Tonkin, and that the CPU also typically produces data

which is output to a display assembly to produce appropriate images on a display screen.

At the second location cited by the Examiner (col. 14, lines 57-59), Tonkin merely discloses the concept of automatically formatting order information so as to facilitate routing and/or document assembly.

At the third location cited by the Examiner (col. 10, lines 23-37), Tonkin merely discloses a means of checking whether a document can be physically created as specified. For example, such means for checking can determine whether the user has specified double-sided printing on media that is capable only of single sided printing, or whether the user has specified color printing for a media that is intended only for black and white printing, or whether the user has specified a binding type that can not accommodate the document because the document would be too thick or too thin, or whether the user has specified printing on media that can not be printed upon, such as vinyl media.

The Appellant notes that in evaluating whether a *prima facie* case of obviousness is established, each term in the claim is to be given its broadest reasonable construction consistent with the specification. (37 CFR 1.56(b)(2)(ii).) The Appellant's specification reads as follows:

"The literature assembly algorithm 205 can comprise a series of computer-executable steps ("a program") which can be stored in the memory 201 and executed by the processor 215. That is, the literature assembly algorithm 205 is preferably configured to cause the processor 215 to access the database 203 and to retrieve therefrom the specific literature which is requested by the client "C." After accessing the database 203, and retrieving the requested literature therefrom, the literature assembly algorithm 205 causes the processor 215 to organize the requested literature together in a logical sequence and order, and formats the literature for printing in the booklet "B" to be produced by the booklet-producing device 130." (specification, page 10, lines 11-19, emphasis added.)

Thus, when viewed in light of the specification, the claim term, "*wherein the algorithm automatically specifies an arrangement of components to create the document*" includes automatically organizing the requested literature together in a logical sequence and order.

5 The Appellant asserts that, not only do the portions of Tonkin cited by the Examiner fail to show that Tonkin teaches or suggests this claim limitation, but also that Tonkin simply does not, at any place therein, teach or suggest this claim limitation. That is, the references do not teach or suggest all the claim limitations because the references do not teach or suggest the limitation, "*providing ... a literature assembly*
10 *algorithm, and ... assembling the selected information into a document, wherein the algorithm automatically specifies an arrangement of components to create the document*" as is required by claim 27.

2) The Examiner has not shown that there is a suggestion or motivation to combine the
15 reference teachings: Obviousness requires some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings. (MPEP 2142.) Moreover, all the teachings of each reference must be considered in the question of whether a suggestion or motivation to combine the references exists. (MPEP 2143.01.) That is, it
20 is improper to take elements of the prior art wholly out of context and give them significance they would not have had to one skilled in the art having no knowledge of the claimed invention, or to anyone else who can read the prior art with understanding. (In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (Fed. Cir. 1988).) In other words, it is impermissible within the framework of § 103 to pick and choose from any one reference
25 only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. (Bausch & Lomb, Inc., v. Barnes-Hind, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).)

The Appellant asserts, in view of the above, that a determination as to whether
30 there is some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to combine the reference teachings must at least take into account the basic inventive matter of the reference teachings as a whole. That is, a proper determination of whether a

suggestion or motivation to combine the reference teachings cannot be based only on an insignificant or inconsequential portion of the reference teachings. Accordingly, it is important to examine the reference teachings as a whole.

5 Tonkin teaches a system that enables a user to preview a document before that document is actually produced. That is, Tonkin teaches a system in accordance with which a user inputs various characteristics of a document, and wherein the system generates a computer-generated simulation, or model, of the document based on the characteristics specified by the user. The user can then look at the model of the document to get a better understanding of the appearance of the actual document if the
10 document were to be produced. (Tonkin, abstract.)

Long teaches a system that reads data from a data card, and then, based on the information, prints a letter on a sheet of media, then also based on the information, selects specific inserts to be included with the letter. After printing the letter and selecting the inserts, the system folds the letter, and stuffs the letter with selected
15 inserts into an envelope and calculates the required amount of postage for the letter, inserts and envelope. (Long, abstract.)

In the final action, the Examiner states that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to calculate the exact postage for the booklet of Tonkin based on the total weight of the booklet and
20 print the electronic image (including the postage) onto one or more sheets of print media at the document production locations, as taught by Long, for the purpose of charging proper postage to the corresponding booklet. (Final action, page 7.)

The Appellant asserts that the Examiner is picking and choosing from the reference teachings in order to support the Examiner's position. That is, the Examiner
25 is relying only upon an insignificant and/or inconsequential portion of what is taught by Tonkin in making the determination that the requisite suggestion or motivation to combine the reference teachings exists. Specifically, the Examiner's position relies upon Tonkin only for teaching "a booklet" and nothing more.

However, what Tonkin discloses is a system for electronically previewing the
30 appearance of a document that has various characteristics specified by a user, and for allowing the user to rearrange the document and/or change the characteristics. The Appellant contends that the Examiner has totally ignored these teachings of Tonkin, and that it is therefore evident that the Examiner has impermissibly excluded all of the

elements of Tonkin necessary to the full appreciation of what Tonkin fairly suggests to one of ordinary skill in the art. Thus, the Examiner has not shown a suggestion or motivation to combine the reference teachings based on some logical reason apparent from positive, concrete evidence that justifies a combination of the reference teachings, as is required. (In re Laskowski, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1985).)

The Appellant also notes that the problem confronted by the inventor must be considered in determining whether it would have been obvious to combine references in order to solve that problem, and that the solution of a problem by the Applicant that is different from that solved by the prior art is a factor weighing toward nonobviousness. (Northern Telecom, Inc., v. Datapoint Corp., 908 F.2d 931, 15 USPQ 2d 1321 (Fed. Cir. 1990), see also In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (Fed. Cir. 1988).) It is apparent from the Appellant's specification that the general problem confronted by the Appellant was that of effectively and efficiently providing printed information to a person who selects such information from a larger database of information.

By contrast, neither Tonkin nor Long confronted the problem that was confronted by the Appellant. Specifically, Tonkin confronted the problem of ensuring a satisfactory appearance of a document before the document is actually produced, while Long confronted the problem of ensuring that the proper corresponding enclosures are included with a letter, and ensuring that the proper postage is affixed to an envelope containing the letter and enclosures. Thus, both Tonkin and Long confronted problems that are significantly different than the problem confronted by the Appellant.

For at least these reasons discussed above, the Appellant contends that there is no suggestion or motivation to combine the reference teachings.

3) The Examiner has employed impermissible hindsight reconstruction: The suggestion or motivation to combine the reference teachings must be shown to exist before the date of invention. (35 U.S.C. 103(a) (*differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made*).) In other words, it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. (In re Fritch 972 F.2d 1260, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1998).)

As is discussed above, the Examiner's explanation of the suggestion or motivation to combine the reference teachings reads as follows:

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to calculate the exact postage for the booklet of Tonkin based on the total weight of the booklet and print the electronic image (including the postage) onto one or more sheets of print media ... (Final Office action, page 7, emphasis added.)

As near as the Appellant can tell, the term "booklet" does not appear anywhere in either Tonkin or Long. Rather, Tonkin uses the term, "document," and Long uses the terms, "letter sheet," "envelope," "enclosures," and "inserts." Similarly, the Appellant has not found anything similar to the phrase or concept of "printing the electronic image including postage" in either of the cited prior art references. Rather, Long simply describes printing postage on an envelope, while Tonkin fails to teach or suggest postage in any way.

On the other hand, the Appellant uses the term "booklet" throughout the specification, including the claims. Likewise, the concept of printing the electronic image including the postage is introduced and explained in detail by the Appellant in the specification, and is also included in one of the limitations of claim 27. That is the Appellant defines at least a portion of the invention in terms of "printing the electronic image including the postage," but this phrase and/or concept is nowhere to be found in the prior art references.

Since the Examiner has used terminology and concepts (i.e., "booklet" as well as the idea and wording of "printing the electronic image including postage") that appear only in the Appellant's specification and not in the references, It can be concluded with near certainty that the Examiner has taken that terminology and those concepts not from the prior art, but directly from the Appellant's own specification and claims.

Thus, it is evident that the Examiner has used the Appellant's own claim terminology as a template in formulating the explanation of the motivation or suggestion to combine the reference teachings. That is, it is evident that the Examiner has employed impermissible hindsight reconstruction in an attempt to render the claimed invention obvious. Stated yet another way, the Examiner has not shown that the

motivation to combine or modify the references existed in the prior art before the date of invention, as is required.

4) The cited prior art teaches away from the claimed invention: A *prima facie* case of obviousness may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. (MPEP 2144.06.) A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be led in a direction divergent from the path that the applicant took. (In re Gurley, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994).)

As discussed above, Appellant's claim 27 includes the following claim limitation: assembling the selected information into a document, wherein the algorithm automatically specifies an arrangement of components to create the document.

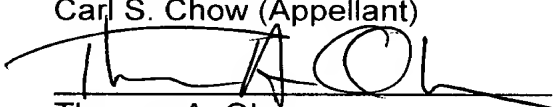
By contrast, Tonkin teaches that the user inputs information specifying an arrangement of components to create the document. (Tonkin, abstract.) That is, the teachings of Tonkin directly contradict the invention of claim 19 because the Appellant claims that the algorithm automatically specifies an arrangement of components to create the document, while Tonkin teaches that the user specifies an arrangement of components to create the document.

Thus, it is evident that a person of ordinary skill in the art, upon reading Tonkin, would be led in a direction divergent from the path the Appellant took. Therefore, even if a *prima facie* case of obviousness had been established, it has been rebutted by the Appellant because the Appellant has shown that Tonkin, in a material respect, teaches away from the claimed invention.

Summary

The Appellant respectfully requests that the Board overturn the final rejections of claims 19-34.

Dated this 24th day of May, 2007

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Serial No. 09/905,579
Docket No. 10007750-1
Appeal Brief

8. Claims Appendix:

Claim 19 (previously presented). A method, comprising:

providing a client interface, a literature assembly algorithm, and a database containing information, wherein the client interface comprises at least a portion of a network;

detecting a client inquiry via the client interface;

presenting the information to the client via the client interface in response to the inquiry;

receiving a client selection of at least a portion of the information via the client interface in response to presenting the information;

in response to receiving the client selection, assembling the selected information into a document, wherein the algorithm automatically specifies an arrangement of components to create the document;

obtaining an electronic image, comprising:

the document; and,

a postage marking calculated based on a total weight of a booklet;

and,

printing the electronic image onto one or more sheets of print media.

Claim 20 (previously presented). The method of claim 19, further comprising:

presenting a name and address prompt via the client interface; and,

receiving a client name and postal address in response to presenting the name and address prompt.

Claim 21 (previously presented). The method of claim 20, wherein the electronic image further comprises the client name and postal address.

Claim 22 (previously presented). The method of claim 19, wherein the ~~further~~ selected
5 information comprises an image to be purchased by the client.

Claim 23 (previously presented). The method of claim 22, wherein the image to be purchased by the client is substantially in the form of sheet music.

10 Claim 24 (previously presented). The method of claim 22, wherein the image to be purchased by the client is substantially in the form of artistic graphics.

Claim 25 (previously presented). The method of claim 22, wherein the image to be purchased by the client is substantially in the form of literary text.

15 Claim 26 (previously presented). The method of claim 22, wherein the image to be purchased by the client is substantially in the form of technical data.

Claim 27 (previously presented). A method, comprising:

providing a literature assembly algorithm and a client interface, wherein the client interface comprises at least a portion of a network;

detecting a client inquiry via the client interface;

5 presenting an information selection prompt via the client interface in response to the client inquiry;

receiving a client selection via the client interface in response to presenting the information selection prompt;

accessing a read only memory device and retrieving selected data corresponding
10 to the client selection;

in response to receiving the client selection, assembling the selected data into a document, wherein the algorithm automatically specifies an arrangement of components to create the document;

obtaining an electronic image comprising:

15 the document; and,
a postage marking calculated based on a total weight of a booklet;
and,
printing the electronic image onto one or more sheets of print media.

20 Claim 28 (previously presented). The method of claim 27, further comprising:

presenting a name and address prompt via the client interface; and,

receiving a client name and postal address in response to presenting the name and address prompt.

Claim 29 (previously presented). The method of claim 28, wherein the electronic image further comprises the client name and postal address.

Claim 30 (previously presented). The method of claim 27, wherein the selected data
5 comprises an image to be purchased by the client.

Claim 31 (previously presented). The method of claim 30, wherein the image to be purchased by the client is substantially in the form of sheet music.

10 Claim 32 (previously presented). The method of claim 30, wherein the image to be purchased by the client is substantially in the form of artistic graphics.

Claim 33 (previously presented). The method of claim 30, wherein the image to be purchased by the client is substantially in the form of literary text.

1.5 Claim 34 (previously presented). The method of claim 30, wherein the image to be purchased by the client is substantially in the form of technical data.

20 -- End of Claims Appendix --

9. Evidence Appendix:

None.

10. Related Proceedings Appendix:

None.

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